

Attorney Docket No.: 50269-0516

**REMARKS/ARGUMENTS**

The Examiner is thanked for the performance of a thorough search. By this amendment, Claim 1, 2, 4, 15, 16, 24, 38, 39, 50, 51, and 59 have been amended to cure some minor typographical errors and to more distinctly claim certain aspects of the invention. No claims have been added or canceled. Claims 1-72 are pending in the application.

**THE REJECTIONS BASED ON 35 U.S.C. § 101**

Claims 1-72 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. This rejection is respectfully traversed.

The Office Action states that the result of Claim 1 is the identity of a message sender. The Office Action attempts to limit the identity recited in Claim 1 to mean the distinguishing unvarying essential character of an individual or thing. The Office Action further states that "there is no substantial credible use for the identity specified in the claim. A determined identity is abstract and not a real-world artifact, thus, the results are not tangible." (See Office Action, Page 3).

It appears that the Office Action applies the law to mean that a claim must explicitly specify the utility of the claimed invention. The Applicants respectfully submit that such a reading is an incorrect reading of the law. The Applicants submit that Claim 1 does in fact recite a non-abstract and real-world artifact. As recited in Claim 1, the identity referred to is the identity of the first participant. In other words, the identity provides a means to identify, among other things, the user, application, device, group, or service making requests of the second participant. The identity of the first participant can be established when a session is initiated between the first and second participants or in some other way. (See for example, Specification,

Y00052US00

20

Attorney Docket No.: 50269-0516

pages 6-7, lines 18-15). Thus, an identity is not abstract concept, it is a practical real-world identifier of a user, application, device, group, or service.

Furthermore, the Office Action acknowledges that there are several real-world uses for determining the identity. The Office Action states that identity can be used for "billing a participant", "determining a price", decrementing an account balance or funds", or providing "notice of denied access." (See Office Action, Page 3). Thus, determining the identity of the first participant has a practical real-world use.

In addition to the points made above, the Applicants also note that Claim 1 has been amended to recite that "on said device, using said identity to maintain a log of the interaction between said first participant by said second participant." This is an additional real-world use of said identity. Thus, for at least these reasons, the Applicants request that the rejection of Claim 1 under 35 U.S.C. § 101 be withdrawn.

Independent Claim 38 is a computer-readable medium claim that recites limitations reasonably analogous to Claim 1. The rejection of Claim 38 under 35 U.S.C. § 101 should be withdrawn for similar reasons to those discussed above.

Dependent Claims 2-37 and 39-72 incorporate the limitations of their base claims (Claims 1 and 38 respectively) and recite further advantageous features. Accordingly, the rejection of Claims 2-37 and 39-72 under 35 U.S.C. § 101 should be withdrawn for the reasons set forth above.

#### THE REJECTIONS BASED ON 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 1-72 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Office Action alleges that "the claim(s) contain subject matter which was not described in the specification in such a way as to enable one

Y00052US00

21

Attorney Docket No.: 50269-0516

skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” (See Office Action, Page 5). This rejection is respectfully traversed.

The Office Action states, as to Claim 1 and 38, that “while a person who controlled Internet access could use a proxy server to intercept certain Internet messages where the proxy server formed a chokepoint, the claim is not limited to that circumstance. The claim is directed to intercepting messages and determining the sender’s identity. The specification does not enable one to intercept **any form of message** and from it, determine the essential character of its sender.” (See Office Action, Page 5)(emphasis added). In addition, the Office Action states that “one of ordinary skill in the art would not be able to perform these steps for **all messages**.” (See Office Action, Page 5)(emphasis added).

First, it appears that the Office Action is indicating that to enable the claimed invention the Applicants have to describe any and all possible uses of a claimed invention (no matter how practical or impractical those uses may be). The Applicants respectfully note that the standard for enablement is to enable one of skill in the art to make and use the invention. Here, the Applicants recite, among other limitations, “intercepting a message” and “determining an identity based on identifier information in the message”. The Applicants respectfully submit that even before the amendment to Claim 1, Claim 1 **did not require** that these steps be performed for any or all forms of messages, and one of skill in the art would be cognizant of this. Accordingly, the specification would not have to explain how these steps are performed for every type of message.

Furthermore, the Applicants believe Claim 1 as amended clarifies that not just any message can be used to determine the identity of the first participant, but it is messages containing identifier information that are used to determine the identity of the first participant.

Y00052US00

22

Attorney Docket No.: 50269-0516

Thus, for at least these reasons, the Applicants request that the rejection of Claim 1 under 35 U.S.C. § 112, first paragraph be withdrawn.

Independent Claim 38 is a computer-readable medium claim that recites limitations reasonably analogous to Claim 1. The rejection of Claim 38 under 35 U.S.C. § 112, first paragraph should be withdrawn for similar reasons to those discussed above.

Dependent Claims 2-37 and 39-72 incorporate the limitations of their base claims (Claims 1 and 38 respectively) and recite further advantageous features. Accordingly, the rejection of Claims 2-37 and 39-72 under 35 U.S.C. § 112, first paragraph should be withdrawn for the reasons set forth above.

#### THE REJECTIONS BASED ON 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-72 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention. This rejection is respectfully traversed.

#### CLAIMS 1 AND 38

The Office Action states that the phrase “determining the identity” in Claims 1 and 38 is an abstract phrase and the term “intercepting a message” is unclear as to whether the message was delivered as intended or not. (See Office Action, Page 7). As discussed above, the Applicants submit that the phrase “determining the identity” is clear.

In addition, the Office Action seems to place a high value on whether an intercepted message is delivered as intended or not. The Office Action elucidates that “within some communities, intercepting a message means to make a surreptitious copy of it rather than

Y00052US00

23

Attorney Docket No.: 50269-0516

stopping its transmission.” (See Office Action, Page 7). The Applicants respectfully submit that Claim 1 is not directed to the manner of delivery of the message.

As mentioned in the Specification, “[t]he present invention is not limited to any particular technique or mechanisms for intercepting messages. Preferably, the mechanism used to intercept messages is capable of both intercepting messages that are in transit, and of reinserting messages (often after some modification) back into transit. It is also preferable that the mechanism be capable of intercepting both messages in both directions: from users 170 to servers 160, and from servers 160 to users 170.” (See Detailed Description, Page 8, lines 3-11). Instead, Claims 1 and 38 recites “determining the identity of the first participant” and “on said device, using said identity to maintain a log of the interaction between said first participant by said second participant.” These limitations may be performed independently of whether a message is delivered as intended or not. Thus, for at least these reasons, the Applicants request that the rejection of Claim 1 under 35 U.S.C. § 112, second paragraph be withdrawn.

Independent Claim 38 is a computer-readable medium claim that recites limitations reasonably analogous to Claim 1. The rejection of Claim 38 under 35 U.S.C. § 112, second paragraph should be withdrawn for similar reasons to those discussed above.

CLAIM 13, 14, 48, and 49

Dependent Claims 13, 14, 48, and 49 were rejected because the term “identity” recited in those claims is allegedly unclear. The Applicants submit that the term identity is clear for at least the reasons discussed above. Thus, the Applicants request that the rejection of Claims 13, 14, 48, and 49 under 35 U.S.C. § 112, second paragraph be withdrawn.

Attorney Docket No.: 50269-0516

CLAIMS 15, 16, 24, 50, 51, AND 59

Claims 15, 16, 24, 50, 51, and 59 were rejected for being allegedly unclear or lacking antecedent basis. The Applicants believe the amendment made to those claims should clarify any ambiguities or antecedent basis issues in the claims. Thus, for at least these reasons, the Applicants request that the rejection of Claims 15, 16, 24, 50, 51, and 59 under 35 U.S.C. § 112, second paragraph be withdrawn.

CLAIMS 2-12, 17-23, 25-37, 39-47, 52-58, AND 60-72

CLAIMS 2-12, 17-23, 25-37, 39-47, 52-58, and 60-72 incorporate the limitations of their base claims (Claims 1 and 38 respectively) and recite further advantageous features. Accordingly, the rejection of these claims under 35 U.S.C. § 112, second paragraph should be withdrawn for the reasons set forth above.

THE REJECTIONS BASED ON 35 U.S.C. § 102

Claims 1-72 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Number 20020138331 filed by Hosea, et al. (Hosea). The rejection is respectfully traversed.

INDEPENDENT CLAIM 1

Independent Claim 1 recites:

A method for communicating electronic information comprising the computer-implemented steps of:  
intercepting a message that has been sent from a first participant to a second participant prior to said message arriving at said second participant;  
wherein intercepting the message is performed by a device coupled between a plurality of clients and a plurality of servers;  
wherein said message includes identifier information;



Attorney Docket No.: 50269-0516

wherein said first participant is one of a service requestor and a service provider and the second participant is the other of the service requestor and the service provider;  
on said device, determining the identity of the first participant based on said identifier information in said message;  
on said device, using said identity to maintain a log of the interaction between said first participant by said second participant; and  
wherein said log is based at least in part on reply messages that pass through said device.

Such a method is not disclosed or taught by Hosea. More specifically, Hosea does not teach or suggest “on said device, using said identity to maintain a log of the interaction between said first participant by said second participant” and “wherein said log is based at least in part on reply messages that pass through said device” as recited in Claim 1. Instead, Hosea describes a system that “delivers a personalized HTML file to the user.” (See Hosea, ¶ 0034). To do so, Hosea receives HTTP requests made by users, retrieves Web pages, “modifies [the] Web pages in accordance with a profile of the requesting user, and provides the modified Web pages to the users.” (See Hosea, ¶ 0034). Basically, based upon a stored profile, Hosea creates a modified Web page and sends the modified Web page as a response to an HTTP request (e.g., as a new message). (See for example, Hosea ¶ 0045 and 0047). Hosea does not maintain any information about the interaction between its Web page requestor and Web page provider. Thus, Hosea clearly does not teach at least one feature of Claim 1. For at least these reasons, the Applicants respectfully request that the rejection of Claim 1 under 35 U.S.C. § 102(e) be withdrawn.

Claim 38 is a computer-readable medium claim reasonably analogous to Claim 1. For at least the same reasons discussed above, the rejection of Claim 38 under 35 U.S.C. § 102(e) should be withdrawn.

Attorney Docket No.: 50269-0516

Further Claims 2-37 and 39-72, which depend from Claims 1 and 38 respectively, and which recite further advantageous aspects of the invention, are likewise patentable over Hosea for at least the reasons given above in connection with Claim 1.

THE REJECTIONS BASED ON 35 U.S.C. § 103(a)

CLAIMS 2-12, 14, 25, 26, 29, 30, 40-47, 49, 60, 61, 64, AND 65

Claims 2-12, 14, 25, 26, 29, 30, 40-47, 49, 60, 61, 64, and 65 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hosea in view of U.S. Patent Application 20020133412 filed by Oliver et al. ("Oliver") in further view of the Federal Trade Commission's 16 CFR CH1 (1-1-98 edition) part 308 ("FTC").

As noted above, Hosea does not teach "on said device, using said identity to maintain a log of the interaction between said first participant by said second participant" and "wherein said log is based at least in part on reply messages that pass through said device" as recited in Claim 1. Oliver and the FTC also do not teach these features of Claim 1. For example, Oliver describes a system that logs information about a user's usage of a system, however, that information is not based on reply messages that pass through said device. The Oliver system trusts its outside providers to send billing information back to its TVS client to be logged. (See Oliver, FIG. 1 and also Page 11, paragraphs 271-275)). In Oliver, this allows for distributed local control of information. It also means that the logs kept by Oliver are based on something (e.g., outside provider reports) other than reply messages that pass through said device. Accordingly, Oliver fails to teach at least one limitation of Claim 1.

The FTC also fails to teach or suggest either of these limitations. The FTC merely describes the statutory requirements 1-900 numbers need to comply with in order to be legal. To be legal, 1-900 numbers have to clearly identify to users how billing rates are applied, when

Y00052US00

27



Attorney Docket No.: 50269-0516

those rates may change, etc. It does not teach “on said device, using said identity to maintain a log of the interaction between said first participant by said second participant” and “wherein said log is based at least in part on reply messages that pass through said device” as recited in Claim 1. Thus, even if the two references were combined (assuming that it would have been obvious to combine the references), the combination fails to teach or suggest elements of Claim 1. Thus, Claim 1 is patentable over Hosea, Oliver, and the FTC, taken individually or in an alleged combination.

Claim 38 is a computer-readable medium claim reasonably analogous to Claim 1. For at least the same reasons discussed above, the rejection of Claim 38 under 35 U.S.C. § 102(e) should be withdrawn.

Further Claims 2-12, 14, 25, 26, 29, 30, 40-47, 49, 60, 61, 64, and 65, which depend from Claims 1 and 38, and which recite further advantageous aspects of the invention, are likewise patentable over Hosea for at least the reasons given above in connection with Claim 1.

As to Claims 4 and 39, the Office Action took official notice “that a workable scheme for billing would have to avoid billing if it was not warranted.” (See Office Action, Page 9). The Applicants generally do not dispute that a workable scheme for billing should not bill if it is not warranted. The Applicants do, however, disagree with the overall context of this official notice and the others. Generally, the Office Action brings up the official notice without any context that would allow the Applicants to better determine if the official notice is applicable to this particular technology art and/or frame of reference. As to Claims 4 and 39, the Applicants respectfully note that when Claim 4 determines billing implications, it does so to determine if a requested service is one that the user has to pay for. None of the official notice, the FTC, and or cited references describe this process. For example, in other instances of the claimed

Y00052US00

28

Attorney Docket No.: 50269-0516

invention, services may be restricted based on other factors, such as the type of service being requested (e.g., the user is too young to access a service). Thus, to this extent and to the extent described above, the official notice and the rejections based on the official notice are respectfully traversed.

As to Claims 8-10 and 43-45, the Office Action took official notice that "determining sufficient or insufficient funds is obvious" and that "pre-paying for access to internet services is old and well known." (See Office Action, Page 10). The Applicant disagrees with the application and conclusions adopted by the Office Action. The conclusions based on the official notice are erroneous. Claims 8-10 and 43-45 relate to determining information about type of service being provided (e.g., does the service require the user to pre-pay for the service?) or the type of user requesting the service (e.g., does the user have a history of non-payment). These are factors that are not taught in the cited references and they are not described by the official notice. Thus, to this extent and to the extent described above, the official notice and the rejections based on the official notice are respectfully traversed.

As to Claims 25 and 60, the Office Action took official notice "that to award a free services prize, the billing data would have to be adjusted for that participant. If the billing data for that participant was kept in a profile then it would be obvious to update the profile." (See Office Action, Page 11). The Applicants respectfully submit that this official notice is conclusory. It does not state any facts. It concludes that given a user profile it would be obvious to store free services awards in those profiles. This may or may not be the case, but to state this as a fact is an error. Thus, to this extent and to the extent described above, the official notice and the rejections based on the official notice are respectfully traversed.

As to Claims 29, 30, 64, and 65, the Office Action took official notice that "online shopping typically includes many validation steps where the participant can confirm or abandon

Y00052US00

29

Attorney Docket No.: 50269-0516

the service requested.” (See Office Action, Page 12). The Applicants do not dispute that fact. However, the Applicants respectfully note that the Office Action uses that official notice to argue that “it would have been obvious to check a profile to determine whether pre-authorization is required.” (See Office Action, Page 13). The Applicants disagree with the conclusion and context in which the official notice is cited. Thus, to this extent and to the extent described above, the official notice and the rejections based on the official notice are respectfully traversed.

CLAIMS 13, 15-24, 27, 28, 33-37, 48, 50-59, 62, 63, AND 66-72

Claims 13, 15-24, 27, 28, 33-37, 48, 50-59, 62, 63, and 66-72 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hosea in view of Oliver.

As noted above, Hosea and Oliver do not teach “on said device, using said identity to maintain a log of the interaction between said first participant by said second participant” and “wherein said log is based at least in part on reply messages that pass through said device” as recited in Claim 1. Accordingly, Oliver fails to teach at least one limitation of Claim 1.

Claim 38 is a computer-readable medium claim reasonably analogous to Claim 1. For at least the same reasons discussed above, the rejection of Claim 38 under 35 U.S.C. § 102(e) should be withdrawn.

Further Claims 13, 15-24, 27, 28, 33-37, 48, 50-59, 62, 63, and 66-72, which depend from Claims 1 and 38, and which recite further advantageous aspects of the invention, are likewise patentable over Hosea for at least the reasons given above in connection with Claim 1.

As to Claims 15 and 50, the Office Action states first that “Oliver does not teach updating profiles based on services requested.” (See Office Action, Page 13). Then the Office

Y00052US00

30

Attorney Docket No.: 50269-0516

Action takes official notice that “it is old and well-known to determine user preferences by services requested and to store the preferences in a user profile, as Oliver does in paragraph 259.” (See Office Action, Page 13). The Applicants respectfully note that Oliver does not teach determining user preferences by services requested. Thus, the assertion that it was old and well-known as of Oliver appears to be in error. Thus, to this extent and to the extent described above, the official notice and the rejections based on the official notice are respectfully traversed.

As to Claims 19, 23, 54, and 58, the Office Action took official notice that “it is old and well-known for the home provider to maintain customer profiles containing billing data and account balances.” The Applicants generally do not dispute that a home provider maintains customer profiles containing billing data and account balances. Here, however, the Applicants respectfully dispute that it would have been obvious to “store billing data and account balances associated with the service requestor in a profile” based on that official notice. (See Office Action, Page 14). Thus, to this extent and to the extent described above, the official notice and the rejections based on the official notice are respectfully traversed.

As to Claims 28 and 63, the Office Action took official notice “that it is old and well-known to send messages explaining services that are unavailable in order to reduce customer confusion when possible.” (See Office Action, Page 14). In Claims 28 and 63, the messages explaining service denials can occur in a variety of contexts (e.g., do not have permission, etc.) that may or may not be encompassed by the official notice. Thus, to this extent and to the extent described above, the official notice and the rejections based on the official notice are respectfully traversed.

As to Claims 36 and 71, the Office Action took official notice “that it was old and well known to limit service to authorized partners.” (See Office Action, Page 14). The Applicants

Y00052US00

31

Attorney Docket No.: 50269-0516

again do not necessarily dispute this fact. However, the Applicants do dispute the conclusions based on the official notice. Thus, to this extent and to the extent described above, the official notice and the rejections based on the official notice are respectfully traversed.

Y00052US00

32

Attorney Docket No.: 50269-0516

**CONCLUSION**

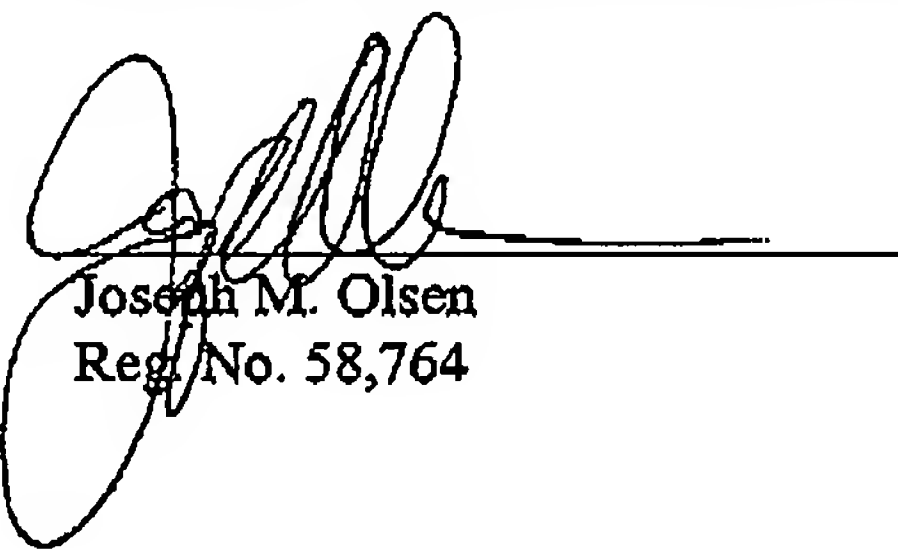
For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



Joseph M. Olsen  
Reg. No. 58,764

2055 Gateway Place, Suite 550  
San Jose, CA 95110  
(408) 414-1080  
Date: May 7, 2007  
Facsimile: (408) 414-1076

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on the date indicated below, at 571-273-8300.

on

5/7/07

by

Martina Placid  
Martina Placid

Y00052US00

33